

Appl. No. : 10/714,724
Filed : November 17, 2003

REMARKS

Claims 1 and 2 have been amended. Claims 1-16 remain pending in the present application. Support for the amendments is found in the specification and claims as filed. Accordingly, the amendments do not constitute the addition of new matter. Reconsideration of the application in view of the foregoing amendments and following comments is respectfully requested.

Double Patenting

Claims 1-7 and 11-16 have been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-7 of U.S. Patent No. 6,649,765.

A timely-filed terminal disclaimer in compliance with 37 C.F.R. § 1.321 (c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with the present application.

U.S. Patent Nos. 6,649,765 and the present application are commonly owned. A Terminal Disclaimer is filed herewith. Accordingly, Applicants respectfully request the Examiner to withdraw the nonstatutory double patenting rejection.

Rejection under 35 U.S.C. § 112, first paragraph

The Examiner rejected Claims 1-7 and 11-16 under 35 U.S.C. § 112, first paragraph. While the Examiner believes that the disclosure is enabling for specific organic solvents, he believes that the specification does not provide enablement for inorganic and other solvents, and suggested that the claims be limited to organic solvents.

Accordingly, Claim 1 has been amended to recite "hydrogenating 5,6-dimethoxy-2-(pyridin-4-yl) methylene indan-1-one with a noble metal catalyst or a non-oxide derivative of a noble metal catalyst in an organic solvent." Claim 2 has been amended to be commensurate with Claim 1.

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The Examiner rejected Claims 1, 3-7, and 11-16 under 35 U.S.C. § 112, first paragraph. The Examiner states that certain solvents are not desired to be used in the process as presently claimed, but are included within the scope of the term solvent in Claim 1, as he cited the specification at page 3, line 7 as stating that the use of oxalyl chloride was not desired.

Paragraph [0006] recites “[o]n reacting 3-[N-(methoxycarbonyl)piperidin-4-yl] propionic acid with oxalyl chloride...” Accordingly, the specification at paragraph [0006] indicates that the prior art chemistry made use of oxalyl chloride as a reagent, not as a solvent because it is part of the reaction. The specification states that “[u]se of oxalyl chloride chemistry is difficult to scale up,” which demonstrates that, in view of the prior art chemistry, one would not consider scaling up the reaction, much less use oxalyl chloride neatly as a solvent. Furthermore, choosing an appropriate organic solvent is within the abilities of one of ordinary skill without undue experimentation, as acknowledged by the Examiner in the obviousness-type double patenting rejection. Because the prior art never suggested using oxalyl chloride as a solvent, and the present claims recite a “solvent” for the hydrogenation step, “oxalyl chloride” does not need to be specifically excluded as a solvent from the present claims.

Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw the rejections under 35 U.S.C. § 112, first paragraph.

Amendment to Claim 1

Claim 1 has been amended to correct the structure of 1-benzyl-4-[(5,6-dimethoxy-1-indanon)-2-yl] methylpiperidine hydrochloride (Donepezil HCl). No new matter has been added.

CONCLUSION

In view of the foregoing amendments and comments, it is respectfully submitted that the present application is fully in condition for allowance, and such action is earnestly solicited.

The undersigned has made a good faith effort to respond to all of the rejections in the case and to place the claims in condition for immediate allowance. Nevertheless, if any undeveloped


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issues remain or if any issues require clarification, the Examiner is respectfully invited to call the undersigned in order to resolve such issue promptly.

Respectfully submitted,

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